

REMARKS

Claims 4-23 are pending in the application and have been rejected by the examiner.

In the Office Action dated November 12, 2000, the examiner rejected claims 4-9 and 11-23 under 35 U.S.C. section 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

In the amendment dated October 12, 2000, applicant incorrectly stated that "In one embodiment, these pilot strength messages may be saved regardless of their strength." Page 10. The correct statement is that pilot strength measurements *are* saved regardless of their strength. The support for pilot strength measurements being saved regardless of their strength can be found at page 9, lines 29-32 of the specification:

Mobile station 2 transmits a Pilot Strength Measurement Message which includes all pilots with energy greater than T_{ADD} and all members of the current active set who's measured pilot energy has not fallen below T_{DROP} for more than a predetermined time period.

Thus, as a matter of course, the mobile station 2 transmits the Pilot Strength Measurement Message to the base station. After the base station receives the Pilot Strength Measurement Message, the base station's handoff control processor 20 provides the information provided in the pilot strength measurement message to PSMM database 21. Page 11, lines 1-3.

The examiner states on page 3 of the Office Action dated November 12, 2000:

As to independent claims 4, 11, 16-17 and 22, the original specification fails to disclose the limitations "**regardless of the measurement value**" as recited in claims 4, 11, 17 and "**regardless of the strength of pilot**" as recited in claims 16, 22. Applicant's attention is directed to the original specification, page 9 line 29 to page 10 line 6, wherein pilot strength satisfies three conditions, *not regardless of the*

measurement value as recited in the claims. Therefore, it is clear that **the measurement values are collected and saved only if they satisfy three conditions.**

Applicant respectfully disagrees. First of all, the three conditions are mentioned with respect to the *exemplary* embodiment, not with respect to the invention in general. The specification states, that "[i]n the *exemplary* (emphasis added) embodiment, mobile station 2 generates and transmits a Pilot Strength Measurement Message (PSMM) following the detection of a change in the strength of a pilot under the following three conditions." Page 9, lines 32-35.

Secondly, examiner's statement that "the measurement values are collected **only if** (emphasis added) they satisfy three conditions" is not only incorrect generally, but is also incorrect with respect to the exemplary embodiment. The specification does not state "a PSMM is transmitted following the detection of a change in the strength of a pilot *only* under the following three conditions." The specification merely enumerates three conditions in which a PSMM is transmitted.

The limitation "regardless of the measurement value" as recited in claims 4, 11, 17 and the limitation "regardless of the strength of pilot" as recited in claims 16, 22 are implicitly disclosed in the specification. As a matter of course, the mobile station 2 transmits the Pilot Strength Measurement Message to the base station and when the base station receives the Pilot Strength Measurement Message, the base station's handoff control processor 20 provides the information provided in the pilot strength measurement message to PSMM database 21. Page 9, lines 29-32, page 11, lines 1-3. Consequently, the rejections of claims 4-9 and 11-23 under 35 U.S.C. section 112, first paragraph, are overcome.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Andersson (5,375,123). Claim 10 as modified overcomes the 35 U.S.C. 102(b) rejection. Claim 10 as modified is patentable since Andersson does not disclose a database for saving data from received pilot strength measurement messages.

Claim 10 is also rejected under 35 U.S.C. 102(b) as being anticipated by Blakeney, II (5,267,261). Claim 10 as modified overcomes the 35 U.S.C. 102(b) rejection. Claim 10 as modified is patentable since Blakeney, II does not disclose a database for saving data from received pilot strength measurement messages.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that all pending claims 4-23 in the application are patentable. Accordingly, reconsideration and allowance of this application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: March 12, 2001

By: 

Albert J. Harnois, Jr.

Reg. No. 46,123

Attorney Applicants

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 651-4368
Facsimile: (858) 658-2502